

REMARKS

Indefiniteness Rejection

The Examiner rejected Claims 22-30 under 35 U.S.C. § 112, second paragraph, as being indefinite because the use of the expression “other semiconductors” encompasses “an innumerable amount of different substances.” Applicants respectfully traverse this grounds for rejection.

By arguing that the claim is indefinite because the phrase (other semiconductors) includes many compounds, the Examiner is rejecting the claim because of its breadth. However, it is well-established by Federal Circuit precedent and in the MPEP that “breadth of [a claim] is not to be equated with indefiniteness.” (*In Re Miller*, 441 F.2d 689, 693 (1971); *see also* MPEP 2173.04). The key inquiry in determining whether a claim is indefinite for failing to particularly point out and claim the subject matter of the invention is “whether the scope of the claim is clear to a hypothetical person possessing the ordinary level of skill in the pertinent art.” (MPEP 2171).

Thus in this case, the proper inquiry is not how many different substances are encompassed by the term semiconductor but whether a person of ordinary skill in the art would understand the scope of materials covered by the term semiconductor. Those skilled in the art would in fact understand what materials are considered semiconductors. For instance, the *Dictionary of Science and Technology* (Academic Press, Christopher Morris, Ed., 1992) defines “semiconductor” as: a crystalline material having intermediate values of electrical resistivity (in the approximate range of 10^{-2} to 10^{-9} ohm-cm, between the values for metals and insulators).

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Although the scope of the invention is to be determined by reference to the present specification, this definition demonstrates that the term semiconductor has a meaning which is well-known to those skilled in the art.

In view of the foregoing, Claim 22 has been amended to describe the addition of a semiconductor to the electrochemically active material, thus deleting the other compounds listed in the Markush group. This amendment is deemed proper because, as just noted above, the term semiconductor is understood by those skilled in the art. New materials listed in Claim 22 prior to this amendment (tin, antimony, arsenic, germanium, indium, selenium, gallium, tellurium) are simply illustrative of what is meant by the term semiconductor and find support in the specification at page 9, line 16-20 and page 12, lines 7-10.

Although the limitation is not considered necessary for compliance with 35 U.S.C. § 112, second paragraph, new Claim 43 is added to include the materials as listed in Claim 1 prior to this amendment and is in accordance with the Examiner's request to more specifically define what is meant by semiconductor.

The Examiner also rejected claim 23 under 35 U.S.C. § 112, second paragraph, as being indefinite because the claim sets forth "metallic tin" as a "compound." Applicants did not intend the word "compound" to only refer to materials made of more than one component. This is evidenced by the fact that Applicant used "metallic tin" as an example of a "compound."

Nevertheless, Applicants have amended the claims to eliminate the word "compound," replace it with the word "semiconductor," and thereby address the Examiner's concern.

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Typographical Rejection

Claim 22 has been amended to make "electrodes" singular as pointed out by the Examiner.

In light of the foregoing, reconsideration of the Application is requested and an early Notice of Allowability is earnestly solicited.

No fee is believed to be due herewith; however, any necessary fee may be charged to deposit account no. 50-0792.

Respectfully submitted,

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